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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/804,039

03/13/2001

Hidefumi Yoshida

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03/16/2006

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EXAMINER

OYEBISI, OJO O

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/804,039

Applicant(s)

YOSHIDA, HIDEFUMI

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/19/05 has been entered.

In the Amendment filed on 12/19/05, the following have occurred: Claims 1, 7, 8 were amended, claims 9 and 10 were added. Claims 1-10 are pending in this office action, and claims 1-10 stand rejected in this office action.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1-10** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for the invention as now claimed i.e., a transaction supporting apparatus in supporting making payment of a transaction including transaction-detail registering means for registering details

of a transaction; including information about a credit card account of the buyer without revealing credit card information to the seller, and charging means for charging by the intermediary agent for the transaction without revealing credit card information to the seller. More specifically, the specification as originally filed does disclose a transaction supporting apparatus in supporting making payment of a transaction including: transaction-detail registering means for registering details of a transaction; payment information notifying means for notifying a buyer of payment information; payment confirming means for confirming whether payment of the transaction has been made to an account specified in the payment information by a deadline also specified in the payment information; and charging means for charging for the transaction via a credit card when the payment confirming means confirms that the payment has not been made by the deadline, but not a transaction supporting apparatus in supporting making payment of a transaction including transaction-detail registering means for registering details of a transaction; including information about a credit card account of the buyer without revealing credit card information to the seller, and charging means for charging by the intermediary agent for the transaction without revealing credit card information to the seller as implied in claims 1, 7-10.

**Re claims 2-6.** Claims 2-6 are rejected because of their dependency from the rejected claim 1 above.

***Claim Rejections - 35 USC § 102***

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Shwartz et al (Shwartz hereinafter, US PAT pub. #:2001/0044787).

**Re claims 1, 7-10.** A transaction supporting apparatus for use by an intermediary agent in supporting payment of a transaction made between a buyer and a seller, said apparatus comprising:

transaction-detail registering means for registering details of the transaction, including information about a credit card account of the buyer without revealing credit card information to the seller (i.e., anonymous transaction, see pg 10 paras 0169 ), payment information notifying means for notifying the buyer of payment information including information about a bank account of the seller into which the buyer is requested to transfer money by other means than the registered credit card account before a specified deadline expires (see pg 11, paras 0196), payment confirming means for confirming whether the requested money transfer has been made (see pg 11, paras 0191-0196) by the other means than the registered credit card account to the seller's bank account by the specified deadline, and charging means (i.e., see fig.1, element 22) for charging by the

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intermediary agent for the transaction without revealing the credit card information to the seller via the credit card account of the buyer (i.e., anonymous transaction, see abstract), only if said payment confirming means finds that the requested money transfer to the seller's bank account by the other means than the registered credit card account has not been made by the deadline.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2 rejected under 35 U.S.C. 103(a) as being unpatentable over Shwartz.

**Re claim 2.** Shwartz does not explicitly disclose the transaction supporting apparatus according to claim 1, further comprising means for sending to the buyer a reminder message which reminds the buyer of payment when the payment confirming means confirms that payment has not been made by the deadline, said charging means charges for the transaction via the credit card when a given period described in the reminder message has expired. However, It is old and well known in the art that when a seller does not receive a payment within a period of time specified in the sale contract, the seller would send a reminder message to the buyer and request that the buyer sends the appropriate

payment. Thus, if the buyer fails to pay within a deadline, then it is commonsensible and obvious that the seller would charge for the transaction using the buyer's credit information on file. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Schwartz in light of what is well known in the art for seller to obtain payment that is due to the seller.

7. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz in view of Keith Lamond

(Keith hereinafter: Credit Card Transactions Real World and Online, see [http://www.virtualschool.edu/mon/ElectronicProperty/klamond/credit\\_card.htm](http://www.virtualschool.edu/mon/ElectronicProperty/klamond/credit_card.htm), 1996, pgs1-17).

**Re Claim 3:** Schwartz discloses a transaction supporting apparatus supporting payment of a transaction made between a buyer and a seller (see abstract). Schwartz does not disclose the transaction supporting apparatus, further comprising means for remitting to the seller an amount obtained by subtracting a given service fee from an amount paid by the buyer. Keith discloses a virtual payment system comprising means for remitting to the seller (i.e., a merchant, pg 7) an amount obtained by subtracting a given service fee (i.e., transaction fees, see pg 7) from an amount paid by the buyer (see pg7, #7). Thus, it would have been obvious for one of ordinary skill in the art to modify Schwartz to include Keith's teaching to allow credit card processing intermediary to collect fee for the services rendered for the use of their infrastructure.

8. **Claims 4 and 6** rejected under 35 U.S.C. 103(a) as being unpatentable over Shwartz in view of Martinez (US PAT 5,208,446).

**Re Claim 4:** Shwartz discloses: The transaction supporting apparatus, further comprising means for inputting card information necessary to charge for the transaction via the credit card (see col.5, lines 63-65). Shwartz does not disclose: card information wherein said information about the credit card account is information that a delivery service agent who delivers a product to the buyer directly obtains from the buyer at the time of a first transaction by the buyer. Martinez discloses: card information being information that a delivery service agent who delivers a product to the buyer directly obtains from the buyer at the time of a first transaction by the buyer (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Shwartz by adapting the teaching of Martinez to to give the buyers the option of paying for goods on delivery.

Further, the art of obtaining credit card information directly from the buyer by the delivery service agent at the point of delivery is old and well known in the parcel delivery business. This is called Cash on Delivery scheme, wherein during the work day, the parcel delivery driver will record parcel delivery information in the parcel tracking system. The information collected usually consist of package Ids, buyer signatures, COD information (i.e., payment information – cash, money order, check, credit etc). This information can be transmitted real time to the host



system. Alternatively, the information could be transferred in batch mode at end of the day. Thus, it would have been obvious to one of ordinary skill to implement this well known scheme in Schwartz to give the buyers the option of paying for goods on delivery.

9. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz in view of Lalonde.

**Re claim 5:** Schwartz discloses the transaction supporting apparatus further comprising means for initiating a money transfer from a specified bank account of the buyer to the bank account of the seller (i.e., the account is settled, see paras 0043 and 0140) wherein said charging means charges for the transaction via the credit card account (see fig.1 element 22). Schwartz does not explicitly disclose charging for the transaction if said payment confirming means finds that said account of the buyer does not have a balance sufficient for the payment to be made by the buyer. However, Lalonde discloses a method for making charge transaction further comprising means for initiating a money transfer from a specified bank account of the buyer to the bank account of the seller (i.e., periodic settlement of accounts as by electronic funds transfer, col 11, line 55-67). Lalonde further discloses a charging means wherein said charging means charges for the transaction via the credit card account if said payment confirming means finds that said account of the buyer does not have a balance sufficient for the payment to be made by the buyer (i.e., credit limit means, col. 10, line 31) (col. 10, lines 31-50). Thus, it would have been obvious to one of ordinary skill in

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the art to modify Shwartz with the credit limit means of Lalonde to ensure that sellers can still receive payments in case the buyer's primary account does not have a balance sufficient for the payment to be made by the deadline.

***Response to Arguments***


10. Applicant's arguments with respect to claim 12/19/05 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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